

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|---------------|-------------------------|-----------|--------------------------------------------------------------|
| Applicant(s): | John McCafferty, et al. | Title: | METHOD FOR PRODUCING MEMBERS OF SPECIFIC BINDING PAIRS |
| App. No.: | 09/417,478 | Art Unit: | 1639 |
| Conf. No.: | 8812 | Examiner: | Liu, Sue Xu |
| Filing Date: | October 13, 1999 | | |

**RENEWED PETITION TO EXPUNGE DOCUMENTS
PURSUANT TO 37 C.F.R § 1.59 SUBMITTED IN AN INFORMATION
DISCLOSURE STATEMENT UNDER 37 C.F.R. §§ 1.97-1.99**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants submit herewith a renewed petition respectfully requesting that certain documents transmitted with the Information Disclosure Statement on November 20, 2002 be expunged (copy enclosed). The attached Petition Decision dated August 4, 2003 indicates upon allowance of the application, applicants should submit a renewed petition to expunge the proprietary material and provide clarification as to the number of references to be expunged.

A Notice of Allowance for the above-identified patent application issued on December 9, 2009 (copy enclosed). The specific references to be expunged are (listed numerically as they appear on the PTO/SB/08A):

6. Redacted Agreement between Medical Research Council, Cambridge Antibody Technology Limited and Cambridge Antibody Technology Group plc, dated 1/7/97 (financial terms redacted);

15. Chiswell memo, dated July 30, 1990, transmitting a copy of the Collaborative Agreement between Cambridge Antibody Technology and The Medical Research Council, dated July 27, 1995;
20. Administration Agreement between Cambridge Antibody Technology Ltd. and Medical Research Council, 8/1/91 (financial terms redacted);
21. Fax from John McCafferty (of Cambridge Antibody Technology Limited) to S. Walton (of Mewburn Ellis) Re: Smith Grant Application;
22. E-mail message from John McCafferty (of Cambridge Antibody Technology Limited) to Brian Kay Re: Smith Grant Application;
23. Letter from John McCafferty (of Cambridge Antibody Technology Limited) to Craig Palmer (of Academic Press) Re: Smith Grant;
24. Fax to John McCafferty (of Cambridge Antibody Technology Limited) from Craig Panner (of Academic Press) dated June 10, 1996; and
25. Smith, G. P., "1988 – A Year of Discovery", *Phage Display of Peptides and Proteins*, Academic Press, Inc. (1996), pp. xvii-xix.

The cited references subject to the protective order were transmitted in a sealed envelope and marked as follows:

MATERIAL SUBJECT TO PROTECTIVE ORDER

**NOT OPEN TO PUBLIC. TO BE OPENED BY EXAMINER
EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND
TRADEMARK OFFICE EMPLOYEE:**

**Tribunal Issuing Protective Order: U.S. District Court for the District of
Columbia, Judge James Robertson**

| | |
|-------------------------------|--------------------------------------------------------------------|
| Civil Action No.: | 1:00 CV 00146 |
| Date of Order: | March 13, 2002 |
| Status of Proceedings: | Not pending |
| In Re Application of: | McCafferty, <i>et al.</i> |
| Application No. | 09/416,902 |
| Filed: | October 13, 1999 |
| For: | METHODS FOR PRODUCING MEMBERS OF SPECIFIC BINDING PAIRS |
| Group Art Unit: | 1639 |
| Examiner: | Amber D. Steele |

Pursuant to 37 C.F.R. § 1.59, Applicants respectfully request that the above-identified documents be expunged from the record and returned to the undersigned attorney.

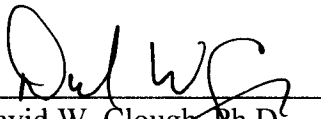
As indicated on the attached Petition Decision, no additional fees are believed to be due in connection with the filing of this renewed petition since the petition fee was previously paid on November 20, 2002. However, should any additional fees be deemed necessary, and proper, the Commissioner is hereby authorized to deduct any such fees from Deposit Account 08-3038.

Respectfully submitted,

HOWREY LLP

Dated: January 12, 2010

By:



David W. Clough, Ph.D.

Registration No.: 36,107

Customer No.: 22930

Telephone No.: (312) 595-1408

HOWREY LLP
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2941 Fairview Park Drive, Suite 200
Falls Church, VA 22042-2924
Facsimile No.: (703) 336-6950



PATENT
Attorney Docket No. 213839-00010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: McCafferty, *et al.*

Serial No.: 09/417,478

Filed: October 13, 1999

Title: Methods for Producing
Members of Specific Binding
Pairs

Group Art Unit: 1627

Examiner: P. Ponnaluri

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the
United States Postal Service on the date shown below
with sufficient postage as first class mail in an envelope
addressed to: Attention: Office of Petitions,
Commissioner for Patents, Washington, D.C. 20231.

11/20/02
Date

David W. Clough, Ph.D.
Registration No. 36,107

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
PURSUANT TO 37 C.F.R. § 1.97-1.99
FILED WITH PETITION TO EXPUNGE
PURSUANT TO 37 C.F.R. § 1.59**

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This Information Disclosure Statement is being submitted pursuant to the applicants' duty of candor and in particular to the applicants' duty to disclose, under MPEP §2001.06(c), information from related litigation such as the charges of inequitable conduct in the parent of the present application, now U.S. Patent No. 5,969,108 (the '108 patent). Applicants request that the documents listed on the attached Form PTO/SB/08A be made of official record in the above-identified application and considered by the Examiner.

Some of the documents being submitted are subject to a protective order in Civil Action No. 1:00 CV 00146 and are being submitted in a sealed, clearly labeled envelope for consideration under MPEP § 724. A Petition to Expunge under 37 C.F.R. § 1.59, along with the fee of \$130 pursuant to 37 C.F.R. § 1.17(h) are also enclosed herewith. If the submitted

documents are found not to be important in deciding whether to allow the application to issue as a patent, applicants respectfully request that the Petition to Expunge under 37 C.F.R. § 1.59 be granted and the documents identified below be returned to the attorney for applicant.

1. Agreement between Medical Research Council, Cambridge Antibody Technology Limited and Cambridge Antibody Technology Group plc, dated 1/7/97 (financial terms redacted);
2. Chiswell memo, dated July 30, 1990, transmitting a copy of the Collaborative Agreement between Cambridge Antibody Technology and The Medical Research Council, dated July 27, 1995; and
3. Administration Agreement between Cambridge Antibody Technology Ltd. and Medical Research Council, 8/1/91 (financial terms redacted).

This same Supplemental Information Disclosure Statement is being filed simultaneously in related application nos. 09/196,522; 09/196,673; 09/309,639; 09/416,902; 09/196,586; 09/417,479; 09/706,507; and 09/726,219. Each of these related applications is currently under examination by Examiner Ponnaluri. In view of the filing of the Petition to Expunge, applicants are transmitting a single copy of the cited references for consideration in each of the related applications.

**Inequitable Conduct Allegations Involving
U.S. Patent No. 5,969,108 (parent of the present application)**

The following is a brief summary of the allegations being made by MorphoSys AG with respect to inequitable conduct in obtaining the '108 patent. MorphoSys has alleged inequitable conduct on the part of Cambridge Antibody Technology Limited, ("CAT"), one of the assignees of the '108 patent, in obtaining the '108 patent. The subject matter claimed in the '108 patent generally relates to the display of single chain antibodies on the surface of filamentous bacteriophage.

One of the bases for the allegation of inequitable conduct is that the applicants did not disclose to the U.S. Patent & Trademark Office a National Institute's of Health ("NIH") grant application by Dr. George Smith relating to the display of small peptides on the surface of phage and which contains a prophetic disclosure of the display of single chain antibodies on the surface of phage which Dr. Smith characterized as speculative in the text of the grant. Documents (including deposition testimony) submitted herewith relate *inter alia* to the

specific allegations made by MorphoSys with regard to this issue, including communications between CAT personnel and their attorneys relating to their knowledge of the existence and public availability of the Smith grant application, and the allegedly cumulative nature of the application in view of what was already before the Patent Office and Dr. Smith's own characterization of what would constitute the invention of the display of single chain antibodies on phage made in a "Declaration" several years after his receipt of the NIH grant.

There is disagreement between CAT and MorphoSys regarding *inter alia* the actual public availability of a Smith grant application, its alleged cumulative and speculative nature in view of material already before the U.S. Patent & Trademark Office and the problems cited by Dr. Smith in his discussion of the display of single chain antibodies on phage in the grant application.

An allegation has also been made that CAT engaged in inequitable conduct by not disclosing to the Patent Office the Smith grant application as relevant to rebut arguments made to the PTO that the art taught away from the display of large peptides on the surface of phage. Nevertheless, the Examiner of the '108 case found that the applicants' arguments regarding that issue had already been rebutted by U.S. Patent No. 5,427,908 to Dower *et al.*, which was already of record in that case and is of record in the present application.

MorphoSys has further alleged that CAT has committed inequitable conduct for their alleged failure to point out the inventor and invention date of each claim that was not commonly owned by CAT and The Medical Research Council ("MRC"), both assignees of the '108 patent, at the time a later invention was made to allow consideration of the applicability of 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. § 103(a). MorphoSys alleges that CAT has failed to show that the subject matter and the claims were, at the time the invention was made, commonly owned. CAT's position supported by deposition testimony (attached herewith) is that there was a clear understanding that the subject matter of each and every claim was commonly owned at all times and the later written agreements submitted herewith simply memorialized the basic understanding between CAT and MRC.

The following documents are being submitted herewith which were recently filed, held or are relevant to the litigation involving the parent of this application in the U.S.

District Court District of Columbia (U.S. District Court, District of Columbia, Civil Action No. 1:00 CV 00146).

1. First Amended Complaint, filed March 8, 2002;
2. Cambridge Antibody Technology Limited's Answer to First Amended Complaint, filed March 22, 2002;
3. Redacted Agreement between Medical Research Council, Cambridge Antibody Technology Limited and Cambridge Antibody Technology Group plc, dated 1/7/97 (**Subject to the Petition to Expunge**);
4. Deposition Transcript of David W. Clough, taken April 19, 2002;
 - a. E. I. du Pont de Nemours & Co. v. Cetus Corp, 19 USPQ2d 1174, (DC D/ N.Cal. 1990) cited in Deposition Transcript of David W. Clough, taken April 19, 2002;
 - b. OddzOn Products Inc. v. Just Toys Inc., 43 USPQ2d 1641 (CAFC 1997), cited in Deposition Transcript of David W. Clough, taken April 19, 2002;
5. Deposition Transcript of George P. Smith, Ph.D., taken May 14, 2002;
6. Deposition Transcript of Dr. David Chiswell, taken April 29, 2002;
7. Deposition Transcript of Dr. Gregory Paul Winter, taken April 30, 2002;
8. Volume I – Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002;
9. Volume II – Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002;
10. Chiswell memo, dated July 30, 1990, transmitting a copy of the Collaborative Agreement between Cambridge Antibody Technology and The Medical Research Council, dated July 27, 1995 (**Subject to the Petition to Expunge**);
11. Declaration of George P. Smith Under 37 C.F.R. § 1.132, executed June 30, 1995 (submitted during the prosecution of U.S. Application No. 08/322,352);

12. Declaration of Professor Brian K. Kay, Ph.D., executed June 28, 1998 (submitted during the prosecution of European Patent Application No. 91913039.3);
13. Abstract of George P. Smith Grant No. 1R01GM41478-01A1.
14. Smith Grant Application, dated November 1, 1988; and
15. Administration Agreement between Cambridge Antibody Technology Ltd. and Medical Research Council, 8/1/91 (**Subject to the Petition to Expunge**).
16. Fax from John McCafferty (of Cambridge Antibody Technology Limited) to S. Walton (of Mewburn Ellis) Re: Smith Grant Application.
17. E-mail message from John McCafferty (of Cambridge Antibody Technology Limited) to Brian Kay Re: Smith Grant Application.
18. Letter from John McCafferty (of Cambridge Antibody Technology Limited) to Craig Palmer (of Academic Press) Re: Smith Grant Application.
19. Fax to John McCafferty (of Cambridge Antibody Technology Limited) from Craig Panner (of Academic Press) dated June 10, 1996.
20. Smith, G. P., "1988 – A Year of Discovery", *Phage Display of Peptides and Proteins*, Academic Press, Inc. (1996), pp. xvii-xix.
21. Northern Telecom Inc. v. Datapoint Corp., 15 USPQ 1321 (CAFC 1990).

Documents 1-12 and 15 are individually listed below with cites to the relevant testimony.

First Amended Complaint, filed March 8, 2002

| | | |
|------|------|------------------------------------|
| Page | Line | |
| 6 | 1 | Allegations regarding Smith grant/ |
| thru | | inequitable conduct |
| 21 | 12 | |

**Cambridge Antibody Technology Limited's
Answer to First Amended Complaint, filed March 22, 2002**

| Page | Line | |
|------|------|-----------------------------------------------------------------------|
| 7 | 8 | Response to allegations regarding Smith grant/ inequitable conduct |
| thru | | |
| 29 | 22 | |

Deposition Transcript of David W. Clough, taken April 19, 2002

| Page | Line | |
|------|--------|---------------------------------|
| 21 | 10 | Testimony regarding Smith grant |
| thru | | |
| 25 | 10; | |
| 27 | 1-15; | |
| 29 | 10 | |
| thru | | |
| 32 | 24; | |
| 33 | 11 | |
| thru | | |
| 40 | 20; | |
| 46 | 4-10; | |
| 55 | 22 | |
| thru | | |
| 57 | 16; | |
| 65 | 10 | |
| thru | | |
| 66 | 14; | |
| 68 | 10 | |
| thru | | |
| 84 | 24; | |
| 88 | 20 | |
| thru | | |
| 95 | 5; | |
| 96 | 16-19; | |
| 97 | 22 | |
| thru | | |
| 99 | 6; | |
| 100 | 15-24; | |
| 101 | 12-21; | |
| 102 | 22 | |
| thru | | |
| 104 | 24; | |

Deposition Transcript of David W. Clough, taken April 19, 2002 (Continued)

| Page | Line | |
|------|--------|------------------------------------------------------|
| 105 | 13 | Testimony regarding Smith grant |
| | thru | |
| 108 | 4; | |
| 108 | 13-22; | |
| 109 | 14-20 | |
| 111 | 1 | |
| | thru | |
| 112 | 3; | |
| 123 | 3-15; | |
| 125 | 1 | |
| | thru | |
| 131 | 2; | |
| 131 | 12 | |
| | thru | |
| 132 | 8; | |
| 141 | 12-15; | |
| 142 | 3-15; | |
| 148 | 9 | |
| | thru | |
| 152 | 7; | |
| 153 | 10 | |
| | thru | |
| 154 | 14; | |
| 155 | 14 | |
| | thru | |
| 156 | 9; | |
| 176 | 8-24 | |
| 105 | 13 | Testimony regarding '96 knowledge of Smith grant |
| | thru | |
| 109 | 20 | |
| 171 | 15 | |
| | thru | |
| 175 | 12 | |
| Page | Line | |
| 176 | 18 | Testimony regarding DuPont v. Cetus |
| | thru | |
| 177 | 20 | |
| Page | Line | |
| 179 | 14-15 | Testimony regarding Oddzn Products v. Just Toys Inc. |

Deposition Transcript of George P. Smith, Ph.D., taken May 14, 2002

| Page | Line | |
|------|--------|---------------------------------|
| 31 | 8 | Testimony regarding Smith grant |
| thru | | |
| 39 | 17; | |
| 40 | 4 | |
| thru | | |
| 49 | 15; | |
| 50 | 25 | |
| thru | | |
| 53 | 25; | |
| 61 | 20 | |
| thru | | |
| 62 | 12; | |
| 64 | 5 | |
| thru | | |
| 65 | 25; | |
| 67 | 6 | |
| thru | | |
| 68 | 8; | |
| 92 | 1-22; | |
| 100 | 24 | |
| thru | | |
| 101 | 13; | |
| 104 | 10-17; | |
| 106 | 12-21; | |
| 111 | 7 | |
| thru | | |
| 112 | 12; | |
| 132 | 12-25; | |
| 141 | 21 | |
| thru | | |
| 142 | 16; | |
| 143 | 14 | |
| thru | | |
| 146 | 25; | |
| 148 | 23 | |
| thru | | |
| 149 | 1; | |
| 155 | 14-22; | |
| 157 | 8 | |
| thru | | |
| 158 | 4; | |
| 162 | 8-20; | |

Deposition Transcript of George P. Smith, Ph.D., taken May 14, 2002

| Page | Line | |
|------|-------|---------------------------------|
| 166 | 10 | Testimony regarding Smith grant |
| | thru | |
| 167 | 12; | |
| 183 | 2-23. | |

Deposition Transcript of Dr. David Chiswell, taken April 29, 2002

| Page | Line | |
|------|------|---------------------------------|
| 119 | 23 | Testimony regarding Smith grant |
| | thru | |
| 124 | 1; | |
| 128 | 5 | |
| | thru | |
| 129 | 5; | |
| 204 | 19 | |
| | thru | |
| 209 | 22 | |

| Page | Line | |
|------|------|-----------------------------------|
| 37 | 2 | Testimony regarding Chiswell memo |
| | thru | |
| 66 | 4; | |
| 94 | 17 | |
| | thru | |
| 96 | 2 | |

| Page | Line | |
|------|------|--------------------------------------------------|
| None | | Testimony regarding '96 knowledge of Smith grant |

| Page | Line | |
|------|------|--------------------------------------|
| 157 | 7 | Testimony regarding common ownership |
| | thru | |
| 158 | 17; | |
| 215 | 19 | |
| | thru | |
| 219 | 15 | |

Deposition Transcript of Dr. Gregory Paul Winter, taken April 30, 2002

| Page | Line | |
|------|--------|---------------------------------|
| 123 | 11-14; | Testimony regarding Smith grant |
| 130 | 22 | |
| | thru | |
| 139 | 14. | |

| Page | Line | |
|------|------|--------------------------------------------------|
| None | | Testimony regarding '96 knowledge of Smith grant |

| Page | Line | |
|------|------|--------------------------------------|
| 74 | 1 | Testimony regarding common ownership |
| | thru | |
| 77 | 22 | |
| 79 | 16 | |
| | thru | |
| 80 | 16 | |
| 82 | 1-11 | |
| 181 | 18 | |
| | thru | |
| 182 | 24 | |
| 222 | 3 | Testimony regarding common ownership |

| | | |
|-----|------|--|
| | thru | |
| 225 | 13 | |

Volume I

Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002

Volume II

Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002

| Page | Line | |
|------|------|---------------------------------|
| 16 | 8 | Testimony regarding Smith grant |
| | thru | |
| 18 | 2; | |
| 31 | 20 | |
| | thru | |
| 59 | 23; | |
| 64 | 11 | |
| | thru | |
| 91 | 6; | |

Volume I
Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002
Volume II
Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002
(Continued)

| Page | Line | |
|------|--------|----------------------------------|
| 93 | 25 | Testimony regarding Smith grant: |
| | thru | |
| 95 | 9; | |
| 95 | 19 | |
| | thru | |
| 96 | 4; | |
| 97 | 19 | |
| | thru | |
| 106 | 21; | |
| 108 | 14 | |
| | thru | |
| 109 | 23; | |
| 110 | 12 | |
| | thru | |
| 111 | 1; | |
| 132 | 17-23; | |
| 133 | 15 | |
| | thru | |
| 140 | 25; | |
| 165 | 21 | |
| | thru | |
| 166 | 18; | |
| 170 | 1-9; | |
| 173 | 16 | |
| | thru | |
| 176 | 11; | |
| 199 | 6 | |
| | thru | |
| 208 | 23; | |
| 228 | 11-13; | |
| 230 | 8-16; | |
| 231 | 7-9; | |
| 232 | 25 | |
| | thru | |
| 243 | 22; | |
| 246 | 16 | |
| | thru | |
| 247 | 10; | |

Volume I
Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002
Volume II
Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002
(Continued)

| Page | Line | |
|------|--------|----------------------------------|
| 249 | 23 | Testimony regarding Smith grant: |
| thru | | |
| 257 | 22; | |
| 267 | 5 | |
| thru | | |
| 268 | 18; | |
| 270 | 21 | |
| thru | | |
| 277 | 22; | |
| 285 | 2 | |
| thru | | |
| 289 | 19; | |
| 321 | 24 | |
| thru | | |
| 322 | 13; | |
| 322 | 18-23; | |
| 323 | 5 | |
| thru | | |
| 328 | 11 | |

| Page | Line | |
|------|------|---------------------------------------------------|
| 82 | 17 | Testimony regarding '96 knowledge of Smith grant: |
| thru | | |
| 90 | 8; | |
| 95 | 19 | |
| thru | | |
| 96 | 4; | |
| 97 | 19 | |
| thru | | |
| 101 | 5; | |
| 103 | 3 | |
| thru | | |
| 106 | 21; | |
| 108 | 14 | |
| thru | | |
| 111 | 1; | |

Volume I
Deposition Transcript of Sean Malcolm Walton, taken May 1, 2002
Volume II
Deposition Transcript of Sean Malcolm Walton, taken May 2, 2002
(Continued)

| Page | Line | |
|------|---------|---------------------------------------------------|
| 133 | 15 | Testimony regarding '96 knowledge of Smith grant: |
| thru | | |
| 140 | 25; | |
| 205 | 5 | |
| thru | | |
| 208 | 23; | |
| 271 | 19 | |
| thru | | |
| 277 | 22; | |
| 285 | 2 | |
| thru | | |
| 289 | 19; and | |
| 321 | 24 | |
| thru | | |
| 328 | 11 | |

| Page | Line | |
|------|------|---------------------------------------|
| 179 | 22 | Testimony regarding common ownership: |
| thru | | |
| 184 | 17; | |
| 186 | 16 | |
| thru | | |
| 191 | 8; | |
| 192 | 22 | |
| thru | | |
| 195 | 19 | |

Chiswell memo, dated July 30, 1990,
(transmitting a copy of the Collaborative Agreement between Cambridge Antibody
Technology and The Medical Research Council, dated July 27, 1995)
(Subject to Petition to Expunge)

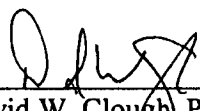
Declaration of George P. Smith Under 37 C.F.R. § 1.132

| Page | Line | |
|------|------|---------------------|
| 2 | 7-9; | Inequitable conduct |
| 4 | 3-9 | |

Finally, attorney for applicants submit herewith a reference (Il'ichev, A.A., *et al.*, "M13 Filamentous Bacteriophage in Protein Engineering", *Molekulyarnaya Biologiya*, Vol. 24, No. 2, pp. 530-535, (March-April 1990)(two versions – one in Russian (with a one-page abstract) and a translation of the same reference) and a patent which were recently brought to applicants' attention.

The Commissioner is hereby authorized to charge any additional fees which may be required in this application under 37 C.F.R. §§1.16-1.17 during its entire pendency, or credit any overpayment, to Deposit Account No. 50-1214. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-1214.

Respectfully submitted,



David W. Clough, Ph.D.
Registration No. 36,107
Attorney for Applicant

November 20, 2002
Katten Muchin Zavis Rosenman
525 West Monroe Street, Suite 1600
Chicago, Illinois 60661-3696
(312) 902-5464
(312) 557-8736

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PTO/SB/08A (10-01)

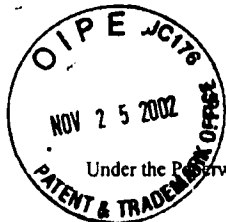
Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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Sheet 1 of 3

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

| | | | | | | | | | | | | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---|---|---|---|---|---|------|---------------------------------------|-------|----------------------------------|---------------------------|
| Substitute for form 1449A/PTO | | | | | | | | | | Docket Number 213839-00010 | | Application Number 09/417,478 | |
| INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary) | | | | | | | | | | Applicant McCafferty <i>et al.</i> | | | |
| | | | | | | | | | | Filing Date October 13, 1999 | | | |
| U. S. PATENT DOCUMENTS | | | | | | | | | | | | | |
| EXAMINER INITIAL | DOCUMENT NUMBER | | | | | | | | DATE | NAME | CLASS | SUB CLASS | FILING DATE IF APPROP. |
| | 1 | 6 | 3 | 3 | 1 | 4 | 1 | 5 | | Cabilly <i>et al.</i> | 435 | 69.6 | 6/10/88 |
| | | | | | | | | | | | | | |
| FOREIGN PATENT DOCUMENTS | | | | | | | | | | | | | |
| | DOCUMENT NUMBER | | | | | | | | DATE | COUNTRY | CLASS | SUB CLASS | Translation Yes No |
| | | | | | | | | | | | | | |
| | | | | | | | | | | | | | |
| OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.) | | | | | | | | | | | | | |
| | 2 | First Amended Complaint, Filed March 8, 2002 - Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (24 pages) (U.S. District Court, District of Columbia)(signed by John S. Skilton, Attorney for Plaintiff.) | | | | | | | | | | | |
| | 3 | Cambridge Antibody Technology Limited's Answer to First Amended Complaint, Filed March 22, 2002 - Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia)(signed by Brian H. Corcoran, Attorney for Defendant). | | | | | | | | | | | |
| | 4 | Ilichev, A.A., <i>et al.</i> , "M13 Filamentous Bacteriophage in Protein Engineering", Molekulyarnaya Biologiya, Vol. 24, No. 2, pp. 530-535, (March-April 1990). | | | | | | | | | | | |
| | 5 | Ilichev, A.A., <i>et al.</i> , "M13 Filamentous Bacteriophage for Protein Engineering", Molekulyarnaya Biologiya, Vol. 24, No. 2, pp. 530-535, (March-April 1990). (In Russian with Translated Abstract) | | | | | | | | | | | |
| | 6 | Redacted Agreement Between Medical Research Council and Cambridge Antibody Technology Limited and Cambridge Antibody Technology Group plc, made 01 January 1997 | | | | | | | | | | | |
| | 7 | Deposition Transcript of David W. Clough, taken April 19, 2002 (Morphosys AG v. Cambridge Antibody Technology Limited, (U.S. District Court, Northern District of Illinois, Eastern Division). | | | | | | | | | | | |
| | 8 | E.I. du Pont de Nemours v. Cetus Corp., 19 USPQ2d 1174, (DC N.Cal. 1990). | | | | | | | | | | | |
| | 9 | OddzOn Products Inc. v. Just Toys Inc., 43 USPQ2d 1641(CAFC 1997). | | | | | | | | | | | |
| EXAMINER | | | | | | | | | | DATE CONSIDERED | | | |
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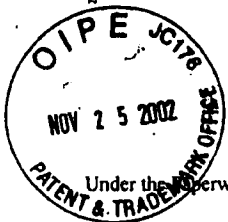
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Sheet 2 of 3

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|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--|---------------------------------------|------|----------------------------------|-------|--------------|---------------------------|
| Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary) | | | | Docket Number 213839-00010 | | Application Number 09/417,478 | | | |
| | | | | Applicant McCafferty <i>et al.</i> | | | | | |
| | | | | Filing Date October 13, 1999 | | Group Art Unit 1627 | | | |
| U. S. PATENT DOCUMENTS | | | | | | | | | |
| EXAMINER INITIAL | DOCUMENT NUMBER | | | | DATE | NAME | CLASS | SUB CLASS | FILING DATE IF APPROP. |
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| FOREIGN PATENT DOCUMENTS | | | | | | | | | |
| | DOCUMENT NUMBER | | | | DATE | COUNTRY | CLASS | SUB CLASS | Translation Yes No |
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| | | | | | | | | | |
| OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.) | | | | | | | | | |
| | 10 | Deposition Transcript of George P. Smith, Ph.D., taken 14 May 2002, Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.) | | | | | | | |
| | 11 | Deposition Transcript of Dr. David Chiswell, taken 29 April 2002; Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.) | | | | | | | |
| | 12 | Deposition Transcript of Dr. Gregory Paul Winter, taken April 30, 2002; Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.) | | | | | | | |
| | 13 | Vol. I - Deposition Transcript of Sean Malcolm Walton, taken 01 May 2002, Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.) | | | | | | | |
| | 14 | Vol. II - Deposition Transcript of Sean Malcolm Walton, taken 02 May 2002, Morphosys AG v. Cambridge Antibody Technology Limited, Case No. 1:00-CV-00146 (30 pages) (U.S. District Court, District of Columbia.) | | | | | | | |
| | 15 | Chiswell memo, dated 30 July 1990, transmitting a copy of the Collaborative Agreement between Cambridge Antibody Technology and The Medical Research Council, dated July 27, 1995. | | | | | | | |
| | 16 | Declaration of George P. Smith, Ph.D., Under 37 C.F.R. § 1.132, executed 30 June 1995 (submitted during the prosecution of U.S. Application No. 08/322,352). | | | | | | | |
| | 17 | Declaration of Brian K. Kay, Ph.D., executed 28 June 1998, (submitted during the prosecution of European Appln. No. 91913039.3) | | | | | | | |
| EXAMINER | | | | | | DATE CONSIDERED | | | |
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|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------|------------------------------------------------------------------------------------------------------------------------------------------------------|--|---------------------------------------|---------|----------------------------------|--------------|---------------------------|
| Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary) | | | | Docket Number 213839-00010 | | Application Number 09/417,478 | | |
| | | | | Applicant McCafferty <i>et al.</i> | | | | |
| | | | | Filing Date October 13, 1999 | | Group Art Unit 1627 | | |
| U. S. PATENT DOCUMENTS | | | | | | | | |
| EXAMINER INITIAL | DOCUMENT NUMBER | | | DATE | NAME | CLASS | SUB CLASS | FILING DATE IF APPROP. |
| | | | | | | | | |
| FOREIGN PATENT DOCUMENTS | | | | | | | | |
| | DOCUMENT NUMBER | | | DATE | COUNTRY | CLASS | SUB CLASS | Translation Yes No |
| | | | | | | | | |
| OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.) | | | | | | | | |
| | 18 | Abstract of George P. Smith, Grant No. 1R01GM41478-01A1, Project Start Date: July 1, 1989. | | | | | | |
| | 19 | Smith Grant Application, entitled: "Filamentous Phage Physiology", dated November 1, 1988 | | | | | | |
| | 20 | Administration Agreement between Cambridge Antibody Technology Ltd. and Medical Research Council, dated 01 August 1991 (Redacted). | | | | | | |
| | 21 | Fax from John McCafferty (of Cambridge Antibody Technology Limited) to Sean Walton (of Mewburn Ellis) regarding the Smith grant application. | | | | | | |
| | 22 | E-mail message from John McCafferty (of Cambridge Antibody Technology Limited) to Brian Kay regarding the Smith grant application | | | | | | |
| | 23 | Letter to Craig Panner (of the Academic Press) from John McCafferty (Cambridge Antibody Technology Limited) regarding the Smith grant application | | | | | | |
| | 24 | Fax to John McCafferty, Ph.D. (of Cambridge Antibody Technology Limited) from Craig Panner (of Academic Press) dated June 10, 1996. | | | | | | |
| | 25 | Smith, G. P., "1988 - A Year of Discovery", <i>Phage Display of Peptides and Proteins</i> , Academic Press, Inc. (1996), pp. xvii-xix. | | | | | | |
| | 26 | Northern Telecom Inc. v. Datapoint Corp., 15 USPQ 1321., (CAFC 1990). | | | | | | |
| EXAMINER | | | | | | DATE CONSIDERED | | |
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AUG 4 2003

DAVID W. CLOUGH, PH.D.
KATTEN MUCHIN ZAVIS
525 WEST MONROE
SUITE-1600
CHICAGO IL 60661-3693

25

In re Application of :
John McCafferty et al :
Serial No.: 09/417,478 : PETITION DECISION
Filed: October 13, 1999 :
Attorney Docket No.: 213839-00010 :

This is a response to the petition under 37 CFR 1.59(b), filed November 25, 2002, to expunge information from the above identified application. The decision on the petition will be held in abeyance until allowance of the application or mailing of an Ex parte Quayle action or a Notice of Abandonment, at which time the petition will be decided.

Petitioner requests that documents submitted as a Proprietary Information Disclosure Statement under a court Protective Order be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid. It is noted that applicants identify three specific documents contained in the envelope as material to be returned. However, the envelope contains four additional documents whose return is not specifically requested. Thus it is not completely clear whether only three documents are to be returned or all seven. A renewed petition at the close of prosecution should clarify this inconsistency.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified documents are considered to be "material." If the information is not considered by the examiner to be material, the information will be returned to applicant upon close of prosecution. See, in general, M.P.E.P. 724.02.

The petition is at this time **DISMISSED** subject to submission of a renewed petition at the time of allowance or abandonment of the application. No additional petition fee will be required for the renewed petition.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703)308-3824 or by facsimile transmission at (703) 308-7230



Bruce M. Kisliuk
Director, Technology Center 1600



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NOTICE OF ALLOWANCE AND FEE(S) DUE

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HOWREY LLP - East
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DR, SUITE 200
FALLS CHURCH, VA 22042-2924

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| EXAMINER | |
| LIU, SUE XU | |
| ART UNIT | PAPER NUMBER |
| 1639 | |

DATE MAILED: 12/29/2009

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/417,478 | 10/13/1999 | JOHN MCCAFFERTY | 05569.0004.DVUS07 | 8812 |

TITLE OF INVENTION: METHODS FOR PRODUCING MEMBERS OF SPECIFIC BINDING PAIRS

| APPLN. TYPE | SMALL ENTITY | ISSUE FEE DUE | PUBLICATION FEE DUE | PREV. PAID ISSUE FEE | TOTAL FEE(S) DUE | DATE DUE |
|----------------|--------------|---------------|---------------------|----------------------|------------------|------------|
| nonprovisional | NO | \$1510 | \$0 | \$0 | \$1510 | 03/29/2010 |

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.